

**REMARKS****Status of the Claims**

Upon entry of the amendment above, claims 1-28 will be pending, claims 1, 13, 14, 22, and 28 being independent. Claims 1-18 and 21-28 are "readable" on the elected invention.

Applicant notes that claim 15 is believed to be "readable" on the elected invention of Figs. 6, 7, contrary to Applicant's previous identification of such claims.

**Summary of the Office Action**

The documents cited in Applicant's previously filed information disclosure statement are considered by the Examiner, as indicated by the Examiner-initialled PTO-1449 form included with the Office action.

Applicants' claim of priority and receipt of the certified copy of the priority application are acknowledged by the Examiner.

The specification is objected to under 37 CFR 1.71 and claim 9 is rejected under 35 USC 112, first paragraph, for allegedly not adequately describing how the lasting allowance or lower ends of the frame are fixed to the lasting allowance.

Claims 1-14 and 16-18 are rejected under 35 USC 112, second paragraph, as being indefinite.

Claims 1-3, 5, 13, and 14 are rejected under 35 USC 102(b) as being anticipated by SPIER (U.S. Patent No. 3,807,062).

Claims 1-8 and 12-14 are rejected under 35 USC 102(e) as being anticipated by SAILLET (U.S. Patent No. 5,901,469).

Claims 1-3, 13, and 14 are rejected under 35 USC 102(b) as being anticipated by BROWN (U.S. Patent No. 4,869,001).

Claims 1-8, 10-14, and 16-18 are rejected under 35 USC 102(e) as being anticipated by HOSHIZAKI et al. (U.S. Patent No. 5,498,033).

**Response to the Office Action****A. Miscellaneous**

Initially, Applicant's undersigned representative wishes to thank the Examiner for her making time to discuss the instant application on June 29, 2001, at which time a sample of a boot made according to the invention was shown. The relative flexibility of the frame of the boot according to the invention was demonstrated, in contrast to the boots described in the cited patents.

Applicant also expresses his appreciation for the Examiner's consideration of the information disclosure statement and her acknowledgement of Applicant's priority claim and receipt of the certified copy of the priority application.

**B. Withdrawal of Objection Under 37 CFR 1.71 and Rejection Under 35 USC****112, First Paragraph and Request for Approval of Drawing Amendment**

Applicant kindly requests that the Examiner reconsider and withdraw the objection to the specification and the rejection of claim 9 under 35 USC 112, first paragraph, regarding the subject matter of claim 9. An objective of claim 9 is to specify that the lower ends of the flexible frame 10 are also fixed between the external sole 4 and the inner sole 7 of the boot. The lasting allowance is believed to be clearly seen in Fig. 5, as it extends beneath the inner sole 7. As described in the specification, although the flexible frame 10 is shown in Fig. 4, the remainder of the upper 2 is not shown, for clarity in understanding the configuration of the flexible frame. Together with the lasting allowance, the "lugs" 16 of the lateral arm 15 (see Figs. 4, 5) are affixed between the inner sole and the external sole, either by means of adhesive, small nails, or stitching. See, e.g., page 7, line 19, to page 8, line 2.

At least based upon the foregoing, reconsideration and withdrawal of the objection and rejection are kindly requested.

Further, inasmuch as reference numeral "24" had not appeared in the drawings, Applicant

is submitting concurrently herewith a proposal to add reference numeral 24 to Fig. 5. The Examiner's approval of same is requested.

**C. Withdrawal of Rejection Under 35 USC 112, Second Paragraph**

In the amendment above, Applicant has introduced certain amendments to claims 1, 9, 13, and 14 for the purpose of improving the form of these claims and for the purpose of having the Examiner withdraw the rejection under 35 USC 112, second paragraph.

The expression "flexible, non-stretchable material" (as used in claims 1, 13, and 14) is defined, e.g., on page 7, lines 1-4, viz., "... a flexible, substantially non-stretchable material, i.e., a material that is substantially non-stretchable for the normal values of forces applied during the practice of the sport considered." Therefore, despite the flexibility of the material, i.e., despite the characteristic that the material can bend during use, it adds rigidity in certain directions particularly because it is non-stretchable. Thus, the expression encompasses any structure that would be so characterized. On page 7, lines 4-5, certain polymers are given as examples of that which would be encompassed. As explained in Ex parte Moelands, 3 USPQ2d 1474, 1476, "... definiteness must not be analyzed in a vacuum, but always in light of teachings ... and skill in the art ...", quoting Moore, 169 USPQ 236 (CCPA 1976) and, in In re Miller, 169 USPQ 597 (CCPA 1971), viz., "breadth is not to be equated with definiteness ..."

The expression "along a preferred direction of forces/supports", as used in original claim 1, has been intended to refer to the direction of forces that are encountered during the use of the boot of the invention. Accordingly, claim 1 has been amended to clarify this point. Specifically, claim 1 has been amended to specify that the material of the flexible frame is "arranged along determinate directions of forces transmitted during use of the boot, said flexible frame being affixed to both the external upper and the outer sole." As an example, the lateral arm extends along a front-to-rear direction to add rigidity where needed, as explained in the specification on page 8, lines 7-9, for example. In summary, Applicant submits that when the

claims are read in light of the disclosure, the metes and bounds of the claims can be reasonably determined.

Regarding claim 3, lateral arms can be situated on respective lateral sides of the boot of the invention. In this way, it can be said that the two lateral arms are symmetrical (along a vertical median plane, for example). Accordingly, the subject matter of claim 3 is believed to be in compliance with §112, second paragraph.

Regarding claim 9, Applicant submits that the expression "lasting allowance" is well-known to those skilled in the art and would be readily understood with reference to Fig. 5, for example. Accordingly, the subject matter of claim 9 is believed to be in compliance with §112, second paragraph.

Regarding claim 14, Applicant submits that the expression "arranged so as to provide a predetermined moment of inertia along a predetermined direction" would also be understood by those skilled in the art. See, e.g., page 8, lines 10-17 of the specification of the instant application. Accordingly, the subject matter of claim 14 is believed to be in compliance with §112, second paragraph.

#### **D. Brief Summary of New Claims**

As mentioned above, new claims 21-26 have been presented, claims 22 and 28 being independent.

New dependent claim 21 is similar to dependent claim 2, but additionally specifies that the top end of the external upper is at about the mid-height of the tibia area of the boot.

New independent claim 22 is somewhat similar to independent claim 13, but additionally specifies that the elongated lateral portion (15) of the flexible frame extends forwardly from the dorsal portion (11) and is spaced above the external sole, i.e., the lateral portion of the frame of the boot is something other than a conventional heel stiffener.

New dependent claims 23 and 24 call for the external upper to extend above an ankle

region to about the mid-height of the tibia.

New dependent claim 25 specifies that the material from which the flexible, non-stretchable material is made is a polymer, which distinguishes the claimed invention from leather, for example. New dependent claim 26 specifies four types of polymers from which the material can be made.

New dependent claim 27 calls for the lateral portion and the dorsal portion of the flexible frame to be unitary.

Finally, new independent claim 28 describes a method by which the boot of the invention is assembled, including "laying flat said external upper and said affixed flexible frame", which is shown, e.g., in Fig. 3, as described in the brief description of the drawings.

#### **E. Withdrawal of Rejections Under 35 USC 102**

Applicant respectfully traverses the grounds of rejection under 35 USC 102. The frame 10 of the boot according to the invention is made of a material which is flexible and substantially non-stretchable. Flexible includes the feature of the invention whereby the material is easily bent with the fingers. Non-stretchable would include the feature whereby along the length of the material, the material cannot be extended by pulling on the two ends, i.e., similar to forces encountered during the use of the boot for its intended purpose.

Applicant submits that, quite surprisingly, although the frame 10 is made of a flexible material, the boot becomes rigid along certain predetermined directions when the frame 10 is attached to the outer sole and to the external upper of the boot, due to the non-extensibility of the material which constitutes the frame.

SPIER discloses a boot having an inner shell portion that has a greater rigidity arranged to provide rigidity to the boot where required for the particular athletic activity for which the boot is used. As can be understood from column 2, lines 64-66 of SPIER, the inner shell 21 must be formed of a relatively rigid plastic material to impart strength, stiffness, and rigidity to

the boot. This idea is confirmed for the other embodiments from column 4, lines 11-16.

In short, the frame of Applicant's invention is flexible, whereas the inner shell of SPIER is rigid.

SAILLET discloses a boot with a flexible upper and a reinforcing frame therein. The frame is made of a rigid material (see column 2, lines 31-32, and column 3, lines 52-53).

Again, the frame of Applicant's boot is flexible, whereas the frame 3 of SAILLET is rigid.

BROWN discloses a boot provided with foot and ankle orthotic. The orthotic is comprised of a foot portion 12 which is adapted to engage the plantar surface of a person's foot, and a rear ankle portion 14, adapted to engage the rear portion of the ankle (see column 15, lines 40-44). The orthotic 10 is placed in the boot 40 so that the orthotic foot portion 12 lies (i.e., is not fixed) on the upper surface of the sole of the boot (see column 16, lines 48-50).

~~X~~ On the contrary, the boot of the invention has a flexible frame that does not lie on the sole, but is affixed to the sole.

BROWN also teaches that Velcro is positioned at the rear vertical inner surface of the boot, which releasably engages the trico layer 38 on the orthotic ankle portion 14 (see column 16, lines 12-21). Accordingly, the orthotic 10 of BROWN is removable. On the contrary, the flexible frame 10 of the invention is not removable.

HOSHIZAKI discloses a skate boot with a molded plastic overlay. The overlay is somewhat inflexible (see column 2, lines 42-47). Again, the boot according to the invention with its flexible frame 10 is new and non-obvious over HOSHIZAKI.

In summary, the cited documents teach the use of a rigid material in order to make a boot more rigid. The invention does the contrary, because it uses a flexible material.

### SUMMARY AND CONCLUSION

The grounds of objection and rejection advanced in the Office action have been addressed

and are believed to be overcome. Reconsideration and allowance are respectfully requested in view of the amendment and remarks above.

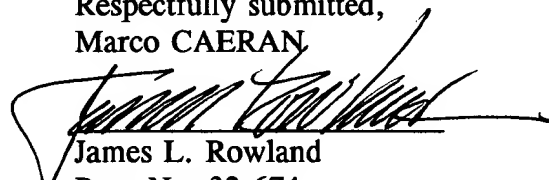
Any amendment to the claims presented above, which has not been specifically noted to overcome a rejection based upon prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach to such amendments.

A check is enclosed for payment of a claim fee and for an extension of time fee. No additional fee is believed to be due at this time. However, the Commissioner is authorized to charge any fee required for acceptance of this reply as timely and complete to Deposit Account No. 19-0089.

Further, although an extension of time for two months is believed to be necessary at this time, if it were to be found that an additional extension of time were necessary to render this response timely and/or complete, Applicant requests an extension of time under 37 CFR 1.136(a) in the necessary increment(s) of month(s) to render this reply timely and/or complete and the Commissioner is authorized to charge any necessary extension of time fee under 37 CFR 1.17 to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone or fax number given below.

Respectfully submitted,  
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**MARKED-UP VERSION OF AMENDMENTS****In the Specification:**

The paragraph appearing on page 4, lines 1-3, is to be replaced with the following paragraph:

-- Surprisingly, the linkage of the frame to the sole and upper makes it possible to notably reinforce the latter in [at] the area [level] of the frame, despite the flexibility of the frame, and to transmit the selected forces. [efforts/supports.] --

The paragraph appearing on page 7, lines 19, to page 8, line 2, is to be replaced with the following paragraph:

-- The seams 21 can be merged with the continuous seams 22 of the upper for aesthetic reasons. The assembly of the lower ends of the frame to the upper 2 can be made by a low peripheral seam, [24,] as shown in FIG. 5, [3,] and/or by means of the insole 7 on which these ends 13, 16 are fixed by adhesive [adhesion] and/or nails [24]. FIG. 5 shows the flexible frame 10 connected to the lasting allowance of the upper 2 between the insole 7 and the external sole 4. In any event, the assembly of at least the lower ends of the frame to the upper is depicted by reference numeral 24 in FIG. 5. --

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**In the Claims**

Claims 1, 9, 13, and 14 are amended as follows:

1. (Amended) A sports boot, especially for gliding sports, comprising:

an outer sole and an external upper covering a [the] user's foot and lower leg, the external upper comprising a flexible frame made of a flexible, substantially non-stretchable material, arranged along determinate [preferred] directions of forces transmitted during use of the boot, said flexible frame being [forces/supports] affixed to both the external upper and the outer sole.

9. (Amended) A sports boot according to claim 1, wherein for a conventional assembly, with the upper having a lasting allowance between an insole and the outer sole, each of the lower ends of the frame is fixed to the lasting allowance.

13. (Amended) A sports boot, especially for gliding sports, comprising an outer sole and an external upper overlying the outer sole and covering a [the] user's foot and lower leg, the external upper comprising a flexible frame made of a substantially non-stretchable material and affixed to the upper and sole, comprising a dorsal portion, extending vertically at the rear of the lower leg, and comprising at least one lateral portion, extending laterally along the foot, connected to said dorsal portion and to the sole, at each of its ends.

14. (Amended) A sports boot, especially for gliding sports, comprising an outer sole and an external upper overlying the outer sole and covering a [the] user's foot and lower leg, the upper including a flexible frame made of a substantially non-stretchable material and arranged so as to provide a predetermined moment of inertia along predetermined directions. }